

## **REMARKS**

### **I. Examiner Interview. Amendments**

Applicant thanks the Examiner for the courtesy of the Examiner Interview held on February 17, 2010. Applicant appreciates the discussion regarding the outstanding rejections so as to better understand the Examiner's comments in the Office Action. Applicant is submitting the instant Amendment as a follow-up to the interview.

Specifically, Applicant has amended claim 1 to recite that the claimed electrical depilator comprises a depilating head consisting essentially of a set of identical unitary single-pieces without additional elements inserted between any of the single-pieces in the set. Support for the expression "depilating head" is provided by the figures, for example, by Fig. 2 at the area indicted by figure reference "A". Support for the expression "identical unitary" is provided *inter alia* by the figures, for example, by Figs. 2 and 3, and by the specification as originally filed at page 6, lines 24-31. Support for the feature that there are no additional elements inserted between any of the single-pieces is provided by the figures, for example, by Fig. 3 and by the specification as originally filed at page 6, lines 24-31.

Applicant has also amended the claim to further clarify that each arm of each single-piece has a clipping surface on one side of each arm, and a supporting portion on the opposite side of each arm of the single-piece. This feature of the pending claims is illustrated in Figs. 4 and 5.

Upon entry of this paper, claims 1-3, 5, and 6 remain pending. No new matter has been added by any amendment herein.

### **II. Rejection under 35 U.S.C. § 102(b)**

Claims 1-6 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by US 5,976,157 to Yiu ("Yiu"). The Examiner alleges that Yiu discloses each of the features of the invention as claimed.

During the Examiner Interview, the Examiner alleged that when considered in its entirety, Yiu's assembled disc assemblies 500 may be considered comparable to Applicant's single-pieces, and that Yiu's disc assemblies are identical and do not have additional elements inserted between the disc assemblies. The Examiner also was of the opinion that Applicant was merely combining

Yiu's three elements (per disc assembly) into a single single-piece and thereby simply engaging in typical optimization procedures.

Applicant disagrees that Yiu discloses the pending claims, and submits that the Examiner can only reconstruct the invention as claimed from Yiu by having the benefit of Applicant's disclosure.

**A. Yiu does not disclose depilating discs with arms having both clipping surfaces and pinching portions.**

Yiu discloses disc assemblies formed of a pair of outer discs and an internal disc assembly. The outer discs 212 are simply flat pieces of metal which only have clipping surfaces and do not have any pinching structures. That is, Yiu's outer discs do not have members which cause the disc assemblies to open and close as they rotate about the shaft. As illustrated in Yiu's Fig. 3, the internal disc assemblies 301 have separate U-shaped members 305 with pinchers 306, and flattened peripheral portions 502. The U-shaped members provide pinching action during rotation so that the flattened peripheral portions and outer discs can form traps for hair. The U-shaped members and the flattened peripheral portions project from the disc and alternate on the perimeter of the internal discs. The U-shaped members do not provide any kind of depilating action but merely cause the disc assemblies to open and close as they rotate.

Yiu does not disclose or suggest placing the U-shaped pincher members on the same arm of the internal disc assemblies, and Yiu does not disclose single discs having both pinching portions and flattened peripheral portions on the same arm.

In contrast, as exemplified in Applicant's Figs. 4 and 5, each arm (or projection) of each of Applicant's single-pieces has a flat clipping surface 51 and a raised supporting portion 52. The clipping surface and supporting portion are on opposite surfaces of the same arm. The clipping surfaces of pairs of single-pieces in the assembled device face each other to provide a clipping gap. As the single-pieces rotate about the arcuate shaft, the supporting portions of adjacent single-pieces cause the clipping gaps to open and close and thereby to pluck hairs from the user's skin.

Accordingly, the structure of Applicant's single-pieces, which have both pinching portions and clipping surfaces on each of the arms, is not the same as the structure of Yiu's internal disc assemblies, and the Examiner cannot maintain the lack of novelty rejection on these grounds.

**B1. Yiu's internal disc assemblies cannot be rearranged without destroying Yiu's invention.**

During the telephone interview, the Examiner suggested that Yiu's disc assemblies could be modified to arrive at Applicant's invention. That is, a person of skill in the art could take Yiu's disc assemblies, discard the pair outer discs, and using only the internal discs assemblies, place the pinchers on the arms of the internal discs to obtain Applicant's single-pieces.

Applicant replies that such a rearrangement would destroy Yiu's invention. Yiu's invention requires that the hair removal device contain pairs of outer discs and an internal disc. The action of discarding the outer discs and rearranging the features of the internal discs would defeat the purpose of Yiu's configuration of discs and would render Yiu's invention inoperable as Yiu intended.

Analogously, one could not remove the pinchers from Yiu's internal discs and place them on the outer discs as such action would also destroy the structure and function of the internal discs.

According to U.S. patent practice, it is impermissible to modify a prior art device if such a modification would destroy the function of the prior art device. Accordingly, the Examiner cannot rearrange and recombine individual elements of Yiu's hair removal device to arrive at the present invention if such a modification would render Yiu's device inoperable.

**B2. Yiu's internal disc assemblies cannot be rearranged to arrive at the pending claims.**

For the sake of argument, even if one were to take a set of Yiu's internal discs without modification, one could not simply place them on an arcuate shaft to arrive at the Applicant's invention.

Placing internal discs in an alternating arrangement on the shaft (U-shaped member, flat portion, U-shaped member, flat portion, etc.) would cause U-shaped members to be interposed between adjacent pairs of flat clipping portions. The flattened peripheral portions of the discs would not be able to mate or come close enough together to form traps for hair.

Alternatively, if one were to arrange the internal discs in such a way that the flattened portions of the internal discs were superimposed, that is, so that the flattened peripheral portions could come together to form traps for hair, the bulky U-shaped members would also be

superimposed on each other. Such a configuration would not allow the flattened portions to rotate close enough to form traps for hair.

Accordingly, one could not develop Applicant's single-pieces from Yiu without the benefit of hindsight gleaned from Applicant's disclosure.

As previously discussed in Section I, above, Applicant has amended claim 1 to recite that the claimed electrical epilator comprises a depilating head consisting essentially of a set of identical unitary single-pieces without additional elements inserted between any of the single-pieces in the set.

By use of the transitional phrase “consisting essentially of”, the claim recites that the epilating head consists of the recited set of identical unitary single-pieces, and may also contain elements which do not materially affect the basic and novel characteristics of the invention as claimed. The claim excludes other elements which would affect the novel characteristics of the depilating head. Applicant submits that this amendment further distinguishes Applicant’s unitary single-pieces over Yiu’s three-part disc assemblies in view of the Examiner’s comments during the telephone interview.

### **III. Conclusion**

Applicant submits that the pending claims are not disclosed or suggested by Yiu. Consequently, the structure of the claimed electrical epilator is not anticipated by Yiu, is distinguishable over Yiu, and cannot be derived from Yiu without destroying Yiu’s invention. The Examiner can only allege the pending claims lack novelty through a hindsight reconstruction of Applicant’s claims with the benefit of Applicant’s disclosure. Accordingly, the rejection under §102(b) is improper and should be withdrawn.

Applicant submits that the pending claims are in condition for allowance, which action is urgently requested.

Applicant requests that the Examiner contact the undersigned Agent by telephone before issuing a subsequent Action if such a discussion would advance the status of the application to allowance.

Authorization is hereby given to charge any fee in connection with this communication to  
Deposit Account No. 23-1703.

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Respectfully submitted,  
/Andrew Fessak/  
Andrew Fessak, Reg. No. 48,528  
Customer No. 07470  
Direct Line: (212) 819-8437